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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,113	02/09/2001	John V. Tyrrell	506812000120	7970

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EXAMINER

MYERS, CARLA J

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 09/09/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/780,113

Applicant(s)

TYRRELL ET AL.

Examiner

Carla Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***RESTRICTION***

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

1. Claims 1, 2, 12, 32-35, 37, 38, drawn to oligonucleotides consisting of SEQ ID NO: 3 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

2. Claims 1, 3, 12, 32-35, 37, 38, drawn to oligonucleotides consisting of SEQ ID NO: 4 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

3. Claims 1, 4, 12, 32-35, 37, 38, drawn to oligonucleotides consisting of SEQ ID NO: 5 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

4. Claims 1, 5, 12, 32-35, 37, 38, drawn to oligonucleotides consisting of SEQ ID NO: 6 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

5. Claims 1, 6, 12, 32-35, 37, 38, drawn to oligonucleotides consisting of SEQ ID NO: 7 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

6. Claims 1, 7, 12, 27, 28, 29, 31, 32-35, 37, 38, drawn to oligonucleotides consisting of SEQ ID NO: 8 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

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7. Claims 1, 8, 12, 32-35, 37, 38, drawn to oligonucleotides consisting of SEQ ID NO: 9 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

8. Claims 1, 9, 12, 32-35, 37, 38, drawn to oligonucleotides consisting of SEQ ID NO: 10 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

9. Claims 1, 10, 12, 32-35, 37, 38, drawn to oligonucleotides consisting of SEQ ID NO: 11 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

10. Claims 1, 11, 12, 32-35, 37, 38, drawn to oligonucleotides consisting of SEQ ID NO: 12 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

11. Claims 13, 14, 26, 32-34, 36, 39 and 40, drawn to oligonucleotides consisting of SEQ ID NO: 13 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

12. Claims 13, 15, 26, 32-34, 36, 39 and 40, drawn to oligonucleotides consisting of SEQ ID NO: 14 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

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13. Claims 13, 16, 26, 27, 28, 32-34, 36, 39 and 40, drawn to oligonucleotides consisting of SEQ ID NO: 15 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

14. Claims 13, 17, 26, 27, 29, 32-34, 36, 39 and 40, drawn to oligonucleotides consisting of SEQ ID NO: 16 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

15. Claims 13, 18, 26, 27, 30, 32-34, 36, 39 and 40, drawn to oligonucleotides consisting of SEQ ID NO: 17 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

16. Claims 13, 19, 26, 32-34, 36, 39 and 40, drawn to oligonucleotides consisting of SEQ ID NO: 18 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

17. Claims 13, 20, 26, 32-34, 36, 39 and 40, drawn to oligonucleotides consisting of SEQ ID NO: 19 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

18. Claims 13, 21, 26, 32-34, 36, 39 and 40, drawn to oligonucleotides consisting of SEQ ID NO: 20 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

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19. Claims 13, 22, 26, 27, 31, 32-34, 36, 39 and 40, drawn to oligonucleotides consisting of SEQ ID NO: 21 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

20. Claims 13, 23, 26, 32-34, 36, 39 and 40, drawn to oligonucleotides consisting of SEQ ID NO: 22 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

21. Claims 13, 24, 25, 26, 32-34, 36, 39 and 40, drawn to oligonucleotides consisting of SEQ ID NO: 23 and methods of detection using said oligonucleotides, classified in Class 435, subclass 6 and Class 536, subclass 24.32.

2. Claims 32-34 link(s) inventions 1-21 above . The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 32-34. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable.

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*In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions 1-21 are drawn to oligonucleotides which are patentably distinct in their structural and functional properties. Each oligonucleotide has its own unique nucleotide sequence and the oligonucleotides are unrelated to one another. These sequences are thus deemed to constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.14.

4. Because these inventions are distinct for the reasons given above and because each invention requires a distinct keyword and nucleotide sequence search that are not co-extensive with one another, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

5. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

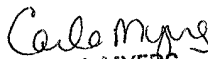
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is (703) 308-2199. The examiner can normally be reached on Monday-Thursday from 6:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703)-308-1152. The fax number for the Technology Center is (703)-305-3014 or (703)-305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Carla Myers

September 4, 2002

  
CARLA J. MYERS  
PRIMARY EXAMINER